PATENT

#25 Received 4/18/95

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	Group Art Unit: 2311
JOSHUA D. KAPLAN	Examiner: R. Weinhardt
Serial No. 08/282,153	RESPONSE TO OFFICE ACTION MAILED OCTOBER 5, 1994
Filed: July 28, 1994	
For: APPARATUS AND METHOD FOR POINT OF PREVIEW AND FOR COMPILATION OF MARKET DATA	

4-19-95 Gcll

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Office Action in this application, mailed on October 5, 1994, applicant respectfully traverses each of the rejections for the reasons as stated below. Applicant responds to the rejections in the order of the numbered paragraphs set forth in the Office Action.

1. Obviousness-Type Double Patenting.

The Examiner has entered a rejection of claims 14-24, 26-29, 33-34, 118-133 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-11 of U.S. Patent No. 5,237,157. (Paragraph #2 of the Office Action Mailed October 5, 1994.) Applicant submitted a Terminal Disclaimer in the parent case, Serial No. 08/035,661 which was entered and resulted in the withdrawal of this rejection in the parent application. (See Office Action mailed February 17, 1994.) At such time as the other rejections in the current application have been overcome, applicant will submit another terminal disclaimer in order to obviate this rejection.

2. Obviousness Rejection of Claims 14-17, 22-23, 26 and 33 in View of Riddell et al., Bradt et al. and Stern et al.

The Examiner has rejected claims 14-17, 22-23, 26 and 33 under 35 U.S.C. § 103 as being unpatentable over Riddell et al. in view of Bradt et al. and Stern et al. Applicant respectfully traverses this rejection because no one of the references discloses all of the elements of the claimed invention, and further, the proposed combination is merely improper hindsight reconstruction of the invention.

The system described in Riddell et al. has as its primary purpose the sale or rental of videocassettes. The focus of this reference is dispensing the videotapes. There is no enabling description of the so-called preview mode so it is not clear that the user of the Riddell et al. system would have any way of choosing among musical selections and controlling the preview playback. Since these limitations are present in the claims and are not suggested in Riddell et al., applicant submits that the claims are patentably distinct from Riddell et al.

Moreover, Riddell et al. do not provide for a subscriber identification capability. The user in Riddell et al. is different than the subscriber in the present claims because the subscriber has already provided pertinent demographic data to the preview service company in the system claimed here.

In order to cure the deficient teachings of Riddell et al., the Examiner has cited Bradt et al. as teaching a "preview" system, and Stern et al. as suggesting the desirability of previewing multiple tracks from a music product. This combination of references is improper hindsight reconstruction of the prior art using the claims as a blueprint. The proposed combination would not be made by one of ordinary skill in the art because each of these references teaches such different systems that there would be no motivation to combine them to achieve the claimed invention. Certainly, there is nothing in the references themselves which would suggest their combination in the manner relied upon by the Examiner.

For example, Riddell et al. and Bradt et al. are very concerned with dispensing cassette products using elaborate mechanical means to deliver the correct cassette to the system user. Bradt et al. are particularly concerned with the system's ability to properly